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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,247	12/19/2001	Stanley Goldman	0176.310US	2717
30560	7590	12/09/2003	EXAMINER	
MAXYGEN, INC. INTELLECTUAL PROPERTY DEPARTMENT 515 GALVESTON DRIVE RED WOOD CITY, CA 94063			DEVI, SARVAMANGALA J N	
			ART UNIT	PAPER NUMBER
			1645	

DATE MAILED: 12/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,247

Applicant(s)

GOLDMAN ET AL.

Examiner

S. Devi, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-121 ~~is/are~~ pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-121 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Restriction

- 1) Claims 1-121 are under prosecution.
- 2) **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hassle, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

- I. Claims 1-25, drawn to a method for modulation of an immune response using a recombinant spore having an exogenous peptide, polypeptide or nucleic acid via a delivery system, classified in class 435, subclass 242.
- II. Claims 26-41, 68-78, 93-100 and 117-121, drawn to a composition comprising a spore system containing an exogenous molecule, classified in class 424, subclass 195.15
- III. Claims 42-49, drawn to a method for releasing a spore system comprising transforming and lysing a cell, classified in class 435, subclass 69.1
- IV. Claims 50 and 51, drawn to a method for displaying a polypeptide on a spore surface, classified in class 435, subclass 931
- V. Claims 52-54, drawn to a detection system comprising spore containing a detectable signal, classified in class 436, subclass 544
- VI. Claims 55 and 56, drawn to a method for detecting a compound comprising contacting a detection spore system, classified in class 435, subclass 7.2
- VII. Claims 57-64, drawn to a method for delivery of a polypeptide, classified in class 935, subclass 52
- VIII. Claims 65 and 66, drawn to a method for generating a desired product by reacting a substrate with a recombinant spore, classified in class 435, subclass 7.72
- IX. Claim 67, drawn to a composition comprising a recombinant spore system having an

enzymatic polypeptide and an enzyme substrate, classified in class 424, subclass 234.1

- X. Claims 79-82 and 86-92, drawn to a composition comprising a spore system comprising expression cassettes encoding a spore coat protein, classified in class 424, subclass 93.2
- XI. Claims 83-85, drawn to a method for modulation of an adjuvant effect in an organism, comprising generating a non-viable spore, classified in class 424, subclass 278.1
- XII. Claims 101-110, drawn to a method of enhancing an immune response to a polypeptide or peptide by administering spores and an expression vector, classified in class 424, subclass 282.1
- XIII. Claims 111-116, drawn to a composition comprising at least two spores displaying different peptides, polypeptides or protein, classified in class 424, subclass 203.1

3) If invention II is elected, Applicants should further elect one of the recited patentably distinct inventions, i.e., spore system containing: peptide, polypeptide or protein; nucleic acid; and carbohydrate, which differ from one another structurally and chemically, requiring separate, non-coextensive searches.

4) Inventions I through XIII are distinct from one another. Inventions II, V, IX, X and XIII are drawn to spore products containing or expressing distinct biomolecules, which differ from one another structurally, physicochemically, functionally, immunologically and/or biologically.

Inventions I, III, IV, VI-VIII, XI and XII are directed to distinct methods, which differ from one another in method steps, parameters and reagents or compositions used, and ultimate goals accomplished.

5) Inventions II and I as well as inventions V and VI are related as product and process of using the product. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process of using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P 806.05(h)). In the instant case, the spore product can be used in a materially different process, for example, for studying sporulation process.

Because these inventions are distinct for the reasons given above and have acquired a

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separate status in the art as shown by their different classification/subclassification and divergent subject matter, and since a search performed for one would not be co-extensive for the other, restriction for examination purposes as indicated is proper.

6) Applicants are advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).

7) Applicants are reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filled petition under C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

8) The Office has required restriction between product and process claims. Where Applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provision of MPEP § 821.04. *Process claims that depend from or otherwise include all the limitations of the patentable product* will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 C.F.R. 1.116; amendments submitted after allowance are governed by 37 C.F.R. 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 C.F.R. 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. § 101, 102, 103 and 112. Until an elected product is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See 'Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C § 103(b),' 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended

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during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the Examiner before the patent issues. See MPEP § 804.01.

9) Any inquiry concerning this communication or earlier communications from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (703) 308-9347. A telephone message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 7.45 a.m. to 4.15 p.m. except one day every bi-week which would be disclosed on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

December, 2003


S. DEVI, PH.D.
PRIMARY EXAMINER